

REMARKS/ARGUMENTS

The non-final Office Action of October 5, 2009 has been carefully reviewed and these remarks are responsive thereto. Claims 1-2, 4-11, and 13-18 have been amended, claims 3, 12 have been canceled without prejudice or disclaimer, and new claim 19 has been added. Claims 1-2, 4-11, and 13-19 thus remain pending in this application. Support for the new claims may be found in Fig. 1 and 1A and in paragraph 51 of the specification as originally filed. No new matter has been added. Reconsideration and allowance of the instant application are respectfully requested.

Rejection Under 35 U.S.C. § 101

Claims 1-18 stand rejected as being directed to non-statutory subject matter. All claims have been amended to method claims which transform data for the creation of iTV applications. Applicants respectfully submit that the rejection is now moot.

Rejections Under 35 U.S.C. § 103

Claims 1, 2, and 5-16 stand rejected under 35 U.S.C. § 103(a) as being unpatentable over U.S. Pat. No. 7,516,468, hereinafter Deller, in view of U.S. Pat. App. No. 2003/0028873, hereinafter Lemmons, and in further view of U.S. Pat. No. 7,363,612, hereinafter Satuloori. Claims 3 and 4 stand rejected under 35 U.S.C. § 103(a) as being unpatentable over Deller, in view of Lemmons, in view of Satuloori, and in further view of U.S. Pat. No. 7,114,170, hereinafter Harris. Claim 17 stands rejected under 35 U.S.C. § 103(a) as being unpatentable over Deller, in view of Lemmons, in view of Satuloori, and in further view of U.S. Pat. App. No. 2002/0078444, hereinafter Krewin. Claim 18 stands rejected under 35 U.S.C. § 103(a) as being unpatentable over Deller, in view of Lemmons, in view of Satuloori, and in further view of U.S. Pat. No. 7,162,697, hereinafter Markel. Applicants respectfully traverse these rejections.

With respect to claim 1, the Office Action concedes that Deller fails to teach a separation of iTV application behavior from content and business rules, but points to Lemmons for such a feature. The Office Action alleges that Lemmons teaches business rules which automatically designate advertising space in media content after production of that content (Office Action, page 5). The

Office Action reasons that because Lemmons' rules do not take application behavior into consideration at all, Lemmons would modify Deller's teaching of content and business rules to be independent of application behavior (Office Action, page 3). Applicants respectfully disagree that Lemmons discloses such a modification.

At most, the Office Action has alleged that Lemmons teaches the separation of business rules (i.e., ad placement) from content (i.e., ads). Even assuming the Office Action is correct on this point, which Applicants do not concede, the Office Action has not shown how this alleged separation of business rules from content teaches a separation of these two features from iTV application behavior, a feature that the Office Action admits is not considered at all in Lemmons. Stated another way, the alleged combination, according to the Office Action's construction, could as well treat iTV application behavior and business rules together, but separate from content. Because Lemmons does not consider iTV application behavior at all, it does not teach or suggest a separation from such behavior as recited in claim 1. Satuloori fails to overcome this deficiency of Deller and Lemmons, and thus claim 1 is allowable of over the combination of Deller, Lemmons, and Satuloori.

Further, even assuming that Deller and Lemmons could be combined in the manner alleged, which again Applicants do not concede, the Office Action has not provided a proper reason to combine the references. The Office Action's reason for combining Lemmons with Deller is for the benefit of efficiently identifying advertising opportunities in order to maximize the amount of advertising (and therefore, profit) in iTV content while reducing/eliminating the amount of manual effort required to place advertisements (Office Action, page 5).

Deller itself discloses that its method and system provides a solution for easy authoring, updating, and providing presentation of interactive and dynamic business data and efficient access to business data over a digital TV network (Deller, col. 2 lines 41-44). Deller discusses how dynamic data is up-to-date, accurate and changes frequently over time to be of continual interest to the user (Deller, col. 1 lines 37-39). Deller further discloses that its invention overcomes prior art which does not allow business data or other forms of interactive and dynamic data to be updated without manual intervention (Deller, col. 1 line 65 – col. 2 line 2). Thus, Deller on its own appears to achieve the stated benefit of reducing manual effort of ad placement. Accordingly, for the Office

Action's stated reason to be proper, the alleged combination must provide some further advantage over Deller alone. Indeed, without some further benefit over the same benefits Deller is already specifically designed to achieve, Deller would teach away from the combination.

As discussed above, Lemmons does not consider iTV application behavior. Thus, the Office Action has not established, at least from Lemmons, that the benefits of efficiently identifying advertising opportunities and reducing the amount of manual effort required to place advertisements would be derived from separating iTV application behavior from business rules and content as recited in claim 1. Any advantage found in Lemmons would, at most, be relevant to only the separation of content and business rules. The Office Action does not provided any other basis for the stated benefits relevant to separating iTV application behavior from content and business rules. Thus, the Office Action's reason to combine Deller and Lemmons is unsupported by any evidence on the record. The alleged combination is accordingly improper and cannot stand.

Claims 2-18 depend from claim 1. Harris, Krewin, and Markel have also been cited, but fail to overcome the deficiencies of the combination of Deller, Lemmons, and Satuloori set forth above. Accordingly, 2-18 are allowable for all the reasons given above and further in view of their specific recitations.

CONCLUSION

All issues having been addressed, Applicants respectfully submits that the instant application is in condition for allowance, and respectfully solicits prompt notification of the same. However, if for any reason the Examiner believes the application is not in condition for allowance or there are any questions, the Examiner is requested to contact the undersigned at (202) 824-3307.

Respectfully submitted,

BANNER & WITCOFF, LTD.

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